

REMARKS

I. Introduction

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

II. Status of the Claims

Claims 1 – 29 are pending. Applicants gratefully acknowledge the PTO's indication that the "one or more compounds" element of the claims was searched in its entirety. In accordance with this consideration and Applicants' previous election of species, the PTO indicated that claims 1 – 7, 9, 10, 12, 13, 15, 16, 21, 22, 24, 25, 27, and 28 are being examined on the merits. Consequently, the PTO has withdrawn from consideration claims 8, 11, 14, 17 – 20, 23, 26, and 29 as being drawn to non-elected subject matter.

Applicants believe, however, that the withdrawal of claims 18 and 19 was in error. These claims should also be examined on the merits because they depend from examined claims 6 and 7, respectively. Therefore, Applicants respectfully request the PTO to include claims 18 and 19 in the claims being examined.

III. The Office Action

Certain combinations of claims, specified below, stand rejected under 35 U.S.C. § 103 as being allegedly obvious over at least EP 0 897 719 ("Franklin") in view of U.S. Pat. No. 5,035,832 ("Takamura"). The individual rejections are discussed below in the order they were presented in the Office Action.

A. Franklin in view of Takamura

Claims 1 – 4, 7, 10, 22, and 28 stand rejected over the combination of Franklin and Takamura. Office Action at pages 2-3. According to the PTO, Franklin teaches a substantially non-aqueous topical cleansing composition comprising a zeolite, kaolin (thickening agent), and PEG-400 (a polyhydric alcohol), together with silica or activated hydrotalcite as a heat generating material. According to the PTO, a preferred embodiment of

Franklin is a shampoo. The PTO concedes, however, that Franklin does not teach the claimed polyoxyalkylene-modified organopolysiloxane.

The PTO believes that Takamura discloses a detergent composition comprising polyether-modified silicones. In the PTO's view, Takamura teaches that such silicones impart "a soft finish, superior tensity to the hair, and superb light feeling to the skin *when added to cosmetic compositions.*" *Id.* at page 3 (emphasis supplied). In light of these considerations, the PTO concluded that it would have been obvious to a person of ordinary skill in the art to combine the polyether-modified silicones as taught by Takamura with the shampoo of Franklin to give a shampoo exhibiting the physical characteristics listed in the excerpt above. Applicants respectfully traverse this rejection.

**1. The Composition of Franklin Is Non-Aqueous But
That of Takamura Is Aqueous**

One of ordinary skill in the art would never have looked to Takamura to improve or modify the anhydrous composition disclosed by Franklin because the composition of Takamura is an aqueous composition. Takamura teaches that the disclosed composition contains "two essential components": a silicone derivative and an alkylsaccharide surface active agent. *See* Takamura at col. 6, ll. 16-19. According to all of the exemplary teachings of Takamura, these compositions contain water as the *major* component. *Id.* at cols. 7-9 (Table 1, Examples 1-5).

By contrast to the aqueous compositions of Takamura, the compositions of Franklin are "anhydrous." *See* Franklin at ¶ 20. Specifically, the disclosed compositions preferably contain less than 0.05 wt% of water. *Id.* at ¶ 21. Thus, a person of ordinary skill in the art with Franklin in hand would not have looked to Takamura because Takamura teaches certain classes of components that give rise to benefits in *aqueous* compositions. For at least this reason, it would not have been obvious to a person of ordinary skill in the art to combine Franklin and Takamura to arrive at the claimed invention.

2. The Properties of Takamura's Composition Flow from The Combination of an Alkylsaccharide and Silicone Compound

As noted above, Takamura explicitly teaches that the disclosed composition comprises the essential combination of an alkylsaccharide and a silicone derivative. Takamura further teaches that the composition's physical properties, upon which the PTO relies for asserting the Franklin/Takamura combination, flows from the specific combination of these two essential ingredients. *See* Takamura at col. 1, ll. 53-62; col. 5, ll. 48-53; and col. 6, ll. 35-41.

There is no suggestion in Takamura whatsoever that "extracting" from the aqueous composition one of the disclosed essential ingredients (the silicone derivative) and "inserting" it into an anhydrous composition, such as one taught by Franklin, would impart the same desirable properties to the anhydrous composition as those arising only from the combination of the two essential ingredients. Therefore, a person of ordinary skill in the art is *not* taught to achieve "a soft finish, superior tensility to the hair, and superb light feeling to the skin", Takamura at Abstract, by adding only the disclosed silicone derivative into the composition taught by Franklin. Absent such a teaching, the person of ordinary skill would not have been motivated to make the combination of references as urged by the PTO.

3. Selecting a Polyoxyalkylene-modified Organopolysiloxane from Takamura Is Impermissible Picking and Choosing

Takamura teaches that one of the essential components is a silicon derivative, as noted above, that can be one among no fewer than nine (9) broad classes of silicon-containing compounds. Although various silicon-containing compounds are broadly disclosed by Takamura, the reference does not contain any direct and/or specific suggestion to employ the specific polyoxyalkylene-modified organopolysiloxanes according to the presently claimed invention. Each of the examples in Takamura employ silicone compounds that are not such organopolysiloxanes. Moreover, there is no suggestion whatsoever that one of ordinary skill could or should employ the subset of polyoxyalkylene-modified organopolysiloxanes having *2 or 3 alkylene carbon atoms* as claimed.

Additionally, it is the particular polyoxyalkylene-modified organopolysiloxanes having 2 or 3 alkylene carbon atoms that give rise to the heat-evolving property of the claimed cosmetic. *See, e.g.*, specification at page 5, line 8-10. Neither Franklin nor Takamura teaches or remotely suggests this relationship.

For these reasons, one of ordinary skill in the art would have had no motivation whatsoever to select the particular subset of heat-evolving polyoxyalkylene-modified organopolysiloxanes having 2 or 3 alkylene carbon atoms as claimed. Making this remarkable selection in the manner urged by the PTO would manifestly require impermissible hindsight reasoning uniquely provided by Applicants' disclosure.

In sum, there is absolutely no basis in the references to select a silicon derivative *by itself* from the aqueous composition disclosed by Takamura, let alone a heat-generating polyoxyalkylene-modified organopolysiloxane that has 2 to 3 alkylene carbon atoms, and add it to the composition of Franklin to obtain the claimed cosmetic composition. For at least these reasons, Applicants' invention is not *prima facie* obvious.

4. The Franklin/Takamura Combination Does Not Suggest the Advantageous Properties of the Claimed Cosmetic

The presence of the recited polyoxyalkylene-modified organopolysiloxane in the claimed cosmetic gives rise to a number of beneficial properties that would not have been expected from the cited references.

First, the polyoxyalkylene-modified organopolysiloxane not only gives rise to heat generation, but does so in a sustained and controlled manner in the context of the claimed invention. *See* Specification at page 4, lines 5-6. By contrast, prior art compositions, such as those of Franklin (Example 1), that employ "polyoxyethylene glycol, glycerol, etc." do not suggest this property.

Second, the polyoxyalkylene-modified organopolysiloxane imparts a superior de-aerating property to the claimed cosmetic. Specification at page 5, lines 4-7. The present cosmetic preferably exhibits high viscosity to prevent the cosmetic from dripping from a

user's skin during application and to prevent separation of the cosmetic components upon storage.

A high viscosity cosmetic, however, generally presents manufacturing problems because stirring and filling the cosmetic into containers introduces substantial air bubbles into the cosmetic, rendering accurate volume measurements difficult. The presence of a polyoxyalkylene-modified organopolysiloxane unexpectedly allows the instant cosmetic to be highly viscous and yet possess a de-aerating property, thereby allowing ease of manufacture. None of the cited references, either individually or in combination, teach or suggest this advantageous property of the present invention.

Thus, even if for purposes of argument, it were to be assumed that there was sufficient motivation to combine the Franklin and Takamura references and that such combination is sufficient to render the claimed invention *prima facie* obvious, a position that Applicants do not endorse, any one or more of the three unexpected properties of Applicants' invention would be sufficient to rebut such a mere presumption of obviousness, i.e., demonstrating that "the invention as a whole" is non-obvious. *See, e.g., In re Murch*, 175 USPQ 89, 91 (CCPA 1972). In addition to the compelling reasons given above why there is no motivation to combine Franklin and Takamura to arrive at the claimed invention, Applicants submit that the foregoing advantageous properties would in any case be sufficient to overcome any alleged *prima facie* case of obviousness based on the Franklin/Takamura combination.

For all of these reasons, Applicants therefore respectfully submit that the claims are not obvious over Franklin and Takamura. Accordingly, Applicants respectfully request the PTO to reconsider and withdraw this rejection.

B. Franklin/Takamura and Maejima

Claims 6, 9, 21, and 27 stand rejected as being allegedly obvious over Franklin and Takamura, further in view of U.S. Pat. No. 5,695,730 to Maejima et al. ("Maejima"). Office Action at pages 4-5. The PTO cites the Franklin/Takamura combination for the reasons discussed above and recognizes that the combination does not teach the claimed silicic acid anhydride or silicic acid hydrate. Additionally, the PTO alleges that the Franklin/Takamura

combination teaches the addition of silica to the disclosed compositions. Consequently, the PTO relies upon Maejima for its alleged disclosure of a silicic acid anhydrate that is acceptable as a filler or flattening agent for cosmetics, among many other recited uses. The PTO considers that the silicic acid anhydrate of Maejima is a silica of the Franklin/Takamura combination. In the PTO's opinion, these considerations engender an expectation that adding silicic acid anhydrate to a cosmetic allegedly derived from the Franklin/Takamura combination would impart "body and uniformity . . . [and] matte effect and softness to the user." Office Action at page 5. Applicants respectfully traverse the rejection.

For all of the reasons discussed in Section A above, Applicants submit that there is no proper basis for combining Franklin and Takamura to arrive at the claimed cosmetic, notwithstanding the absence of the requisite silicic acid anhydride or hydrate. Maejima is directed to a process for preparing silicic acid hydrate. But the reference makes only passing reference to the material's possible use in a cosmetic. The disclosure of Maejima, therefore, does not remedy all of the above-referenced deficiencies of the Franklin/Takamura combination, whether or not Maejima fairly suggests the use of silicic acid hydrate in a cosmetic. Consequently, Applicants courteously submit that Franklin, Takamura, and Maejima do not obviate the invention. Accordingly, Applicants respectfully request the PTO to reconsider and withdraw this rejection.

C. Takamura/Franklin and Coury

Claim 5 stands rejected as being allegedly obvious over the Takamura/Franklin combination further in view of U.S. Pat. No. 6,261,544 to Coury et al. ("Coury"). Office Action at pages 5-6. The PTO relies upon Coury for its purported disclosure of sodium polyacrylate powder, which the Takamura/Franklin combination lacks. In the PTO's opinion, fillers "impart body or rigidity to compositions, and/or softness; a matte effect and uniformity to a composition." Office Action at page 6. The PTO concludes that the sodium polyacrylate powder taught by Coury is a filler and would thus impart these characteristics to a cosmetic, and for that reason, sodium polyacrylate would give rise to an expectation of achieving the claimed cosmetic composition. Applicants respectfully traverse the rejection.

For all of the reasons discussed in Section A above, there is no proper basis for combining Franklin and Takamura, and even if there were, the combination would not obviate the invention. Coury does not remedy the deficiencies of the Franklin/Takamura combination. For at least this reason, the combination of three references does not obviate the invention.

Additionally, Coury does not suggest to a person of ordinary skill that sodium polyacrylate powder should be added to a cosmetic composition. Coury lists legions of “ingredients which are usually present in cosmetic compositions,” Coury at col. 14, ll. 6-7, only one of which is sodium polyacrylate. There is absolutely no suggestion whatsoever in the reference that sodium polyacrylate should be selected as a filler among many other recited fillers. *Id.* at col. 14, ll. 45-52. Absent some motivation or suggestion to pick sodium polyacrylate as the filler of choice for a cosmetic composition, as the PTO implicitly reads into Coury, a person of ordinary skill in the art would have had no reason to consider the claimed cosmetic obvious. Therefore, Applicants submit that the invention is not obviated by Franklin, Takamura, and Coury. Accordingly, Applicants respectfully request the PTO to reconsider and withdraw this rejection.

D. Franklin/Takamura/Coury and Macchio

Claims 13, 16, and 25 stand rejected as being allegedly obvious over the mosaic of the Franklin/Takamura/Coury combination as discussed above in further view of U.S. Pat. No. 5,023,075 to Macchio et al. (“Macchio”). Office Action at page 6. The PTO relies upon Macchio for its purported disclosure of “polyacrylate powders . . . having an average particle size of 10 microns . . .” *Id.* In the PTO’s view, Macchio teaches that cosmetics containing such powders are non-pore clogging and are ultra-smooth upon application. A person of ordinary skill in the art, the PTO concludes, would have considered it obvious to add the sodium polyacrylate powder having an average size of 10 microns as allegedly taught by Macchio to the purported cosmetic resulting from the combination of Franklin, Takamura, and Coury. Applicants respectfully traverse the rejection.

As discussed at length above, Franklin and Takamura are not properly combined and even if they were, Coury does not remedy the deficiencies of the combination.

Notwithstanding this hurdle, Applicants kindly point out that Macchio does *not* teach sodium polyacrylate as claimed. The excerpts relied upon by the PTO refer instead to polymethyl methacrylate, which is not sodium polyacrylate.

Even if one were to accept the PTO's interpretation of Macchio as teaching sodium polyacrylate, a position that Applicants do not endorse, the reference explicitly teaches that the physical properties relied upon by the PTO result from the combination of polymethyl methacrylate, nylon, and polyethylene as "critical ingredients." Macchio at col. 1, ll. 64-66. There is absolutely no basis in the reference for a person of ordinary skill in the art to expect that a cosmetic composition containing only one of these critical ingredients to possess the same properties as if all critical ingredients were present. Yet that is precisely the underlying rationale of this rejection. Therefore, Applicants courteously submit that Macchio cannot be combined with Franklin, Takamura, and Coury to obviate Applicants invention. Accordingly, Applicants respectfully request the PTO to reconsider and withdraw this rejection.

E. Franklin/Takamura/Maejima/Coury/Macchio

Claims 12, 15, and 24 stand rejected as being allegedly obvious over the five-way combination of Franklin, Takamura, Maejima, Coury, and Macchio. In the PTO's view, the Franklin, Takamura, and Maejima as discussed above does not teach the sodium polyacrylate powder, for which the PTO relies upon the combined teachings of Coury and Macchio, also discussed above. Applicants respectfully traverse this rejection.

Drawing upon the remarks from above, Applicants submit, as before, that Franklin and Takamura are not properly combined, even with the teachings of Maejima. There is no suggestion in Coury to select sodium polyacrylate, and Macchio does not even teach sodium polyacrylate, much less as particles measuring 1 to 80 microns as claimed. Therefore, Applicants submit that this rejection is improper and respectfully request the PTO to reconsider and withdraw it.

IV. Claims 8 and Claims Depending Therefrom

In view of the foregoing explanations, it is believed apparent that the subject matter defined by independent claim 8 is also patentable over the prior art, for the same reasons applying to the other independent claims. Therefore, upon allowance of the claims reading on the elected species (as to "component (b)"), Applicants respectfully request that the PTO re-include and allow presently withdrawn independent claim 8 and all other claims that depend directly or indirectly therefrom.

V. Conclusion

Applicants believe that they have satisfactorily resolved all of the outstanding issues in the present application, and therefore submit that it is now in condition for allowance. Applicants therefore seek an early notice to that effect. If the Examiner feels that a telephone interview would advance the prosecution of the present application, she is invited to contact the undersigned by telephone.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.